

REMARKS

Applicant is submitting herewith drawings that overcome the examiner's objection to the drawings. In particular, Figure 1 has been labeled "Prior Art" as requested by the examiner.

PRIOR ART REJECTIONS

In response to the Examiner's rejection of Claims 1-3, 5-8, 10-13, 21-24, 26-29 under 35 U.S.C. 103 as being unpatentable over US Patent No. 6,741,980 to Langseth et al. ("Langseth"), the rejection of claims 14-19 under 35 U.S.C. 103 as being unpatentable over Langseth and further in view of the Human Factors Design Guide ("Design Guide"), the rejections are improper because the examiner has not established a *prima facie* case of obviousness for the reasons set forth below.

Prima Facie Obviousness Standard

To establish a *prima facie* case of obviousness, "...Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following: (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference; (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately; (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and (4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness. See *MPEP 2134.A*.

In the present case, the examiner has not established a *prima facie* case of obviousness because, for each independent claim, the examiner has not made the findings that: 1) the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference. Therefore, the examiner has not established a *prima facie* case of obviousness and the rejections must be withdrawn.

Claims 1-3 and 5

Claim 1

The examiner has not established a prima facie case of obviousness for this claim because the examiner has not shown that: 1) the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.

“Creating a program that utilizes an Internet connection to provide real time odds and information without utilizing a web browser, said real time odds and information being downloaded and stored on a user's computer, and wherein said program being incapable of placing bets”

Claim 1 recites “creating a program that utilizes an Internet connection to provide real time odds and information without utilizing a web browser, said real time odds and information being downloaded and stored on a user's computer, and wherein said program being incapable of placing bets” which does not exist in Langseth. In particular, Langseth discloses a system in which information is delivered to the user periodically. *See Langseth at Col. 3, lines 16-26.* Thus, real time odds and information are not being provided to the user in Langseth. While Langseth does disclose that a sports channel may include “bets and odds index” (*See Langseth at Col. 8, line 65- which is the only support cited by the examiner for most of the claim elements*), it does not disclose the real time odds and information is being downloaded to the user's computer as set forth in the claims. Furthermore, although Langseth discloses a concept of “alerts” which provide immediate notification (*See Langseth at Col. 5, lines 5-9 and Figure 9*), those alerts are for the finance channel (not the sports channel that includes bets and odds index) and illustrate that Langseth does not in fact disclose real time odds and information as set forth in the claims.

Furthermore, contrary to the examiner's assertion that “Langseth is therefore inherently capable of sending the same type of notice in respect to odds”;

“To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'” *In re Robertson*, 169 F.3d 743, 745, 49

USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). *MPEP*
2163.07(a)

In this particular case, there is no evidence that the missing descriptive matter is necessarily present in the thing described in the reference and therefore it is not “inherent” per *MPEP* 2163.07(a).

Thus, this claimed element is not found in the prior art.

“Providing means for a display of real time odds and information, including a bet tracker, a major line move alert, or a line seeker alert”

Claim 1 also recites “providing means for a display of real time odds and information, including a bet tracker, a major line move alert, or a line seeker alert” which does not exist in Langseth. The examiner argues that

“Langseth essentially teaches a Line Seeker feature that provides an alert when predetermined odds on a particular game are offered by a sports book enabling the user to get the information needed automatically. Langseth teaches sending alerts concerning odds. Langseth teaches notifying a user when a stock price reaches a certain level (Fig 9) Langseth is therefore inherently capable of sending the same type of notice in respect to odds.” *See Office action at pg. 3.*

However, as set forth above, pursuant to *MPEP* 2163.07(a), the examiner has not show and cannot show that the Line Seeker claim feature is “inherently” present in Langseth.

Furthermore, as set forth above, while Langseth specifically discloses that, for the financial channel, an alert can be provided (Figure 9), it does not disclose that such an alert is provided for the sports channel. Thus, while Langseth clearly contemplated that an alert can be provided, Langseth also clearly did not believe that an alert would be provided for the sports channel because it would have otherwise been described.

Thus, this claim element is also not found in the prior art.

“Providing means for navigating said display in order to acquire information, said navigation means comprising a menu made up of various menus, and for any

particular game or bet, the program being capable of visually cycling through odds for different sport books”

Claim 1 also recites “providing means for navigating said display in order to acquire information, said navigation means comprising a menu made up of various menus, and for any particular game or bet, the program being capable of visually cycling through odds for different sport books” which is not found in Langseth. The examiner has argued that navigation menus are disclosed in Langseth (Figure 14) and then argued that “it would be a matter of obvious design choice to have a menu that ... for any particular game or bet, the program is capable of visually cycling through odds from different sports books.” *See Office action at 4.*

The examiner’s position is incorrect because: 1) Figure 14 is an output of the Langseth system using HTML that has graphical elements, but does not in fact disclose any menus as asserted by the examiner (*See Langseth at col. 22, lines 31-39*); and 2) even if Langseth discloses menus as asserted by the examiner, which Langseth does not, the capability to visually cycle through odds for different sport books as set forth in the claim is clearly not simple a matter of obvious design choice because Langseth does not even disclose that it can displays odds for different sports books.

Thus, the claim element is not found in Langseth.

Summary

Thus, at least three claim elements are not found in Langseth and the examiner has therefore failed to show a prima facie case of obviousness since the examiner has not shown that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.

Claims 2-3 and 5

These claims depend from independent claim 1 and the examiner has not established a prima facie case of obviousness for these claims for at least the same reasons as set forth above for claim 1.

Claims 6-8 and 10

Claim 6

The examiner has not established a prima facie case of obviousness for this claim because the examiner has not shown that: 1) the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.

“Creating a program that utilizes an Internet connection to provide real time odds and information without utilizing a web browser, said real time odds and information being downloaded and stored on a user's computer, and wherein said program being incapable of placing bets”

Claim 6 recites “creating a program that utilizes an Internet connection to provide real time odds and information without utilizing a web browser, said real time odds and information being downloaded and stored on a user's computer, and wherein said program being incapable of placing bets” which does not exist in Langseth for the same reasons as claim 1 above and the argument will not be repeated here.

“Providing means for navigating said display in order to acquire information said navigation means comprising a menu made up of various menus, and for any particular game or bet, the program being capable of visually cycling through odds for different sport books”

Claim 6 also recites “providing means for navigating said display in order to acquire information, said navigation means comprising a menu made up of various menus, and for any particular game or bet, the program being capable of visually cycling through odds for different sport books” which is not found in Langseth for the same reasons as claim 1 above and the argument will not be repeated here.

Providing means for downloading and storing bets on the user's computer, analyzing the information, and logging and tracking bets for a total of winnings and losses.

Claim 6 also recites “providing means for downloading and storing bets on the user's computer, analyzing the information, and logging and tracking bets for a total of winnings and

losses” which is not found in Langseth. In the office action, the examiner has offered not support for the assertion that Langseth discloses this claim element. Langseth in fact does not disclose this claim element as the only disclosure in Langseth about bets and odds are at Col. 8, line 65 (which was repeatedly cited by the examiner). Thus, this claim element is not found in Langseth.

Summary

Thus, at least three claim elements are not found in Langseth and the examiner has therefore failed to show a prima facie case of obviousness since the examiner has not shown that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.

Claims 7-8 and 10

These claims depend from independent claim 6 and the examiner has not established a prima facie case of obviousness for these claims for at least the same reasons as set forth above for claim 6.

Claims 11- 19 and 21

Claim 11

The examiner has not established a prima facie case of obviousness for this claim because the examiner has not shown that: 1) the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.

“Creating a program that utilizes an Internet connection to provide real time odds and information without utilizing a web browser, said real time odds and information being downloaded and stored on a user's computer, and wherein said program being incapable of placing bets”

Claim 11 recites “creating a program that utilizes an Internet connection to provide real time odds and information without utilizing a web browser, said real time odds and information being downloaded and stored on a user's computer, and wherein said program being incapable of

placing bets” which does not exist in Langseth for the same reasons as claim 1 and the arguments are not repeated here.

“Providing means for navigating said display in order to acquire information, said navigation means comprising a menu made up of various menus, and for any particular game or bet, the program being capable of visually cycling through odds for different sport books”

Claim 11 also recites “providing means for navigating said display in order to acquire information, said navigation means comprising a menu made up of various menus, and for any particular game or bet, the program being capable of visually cycling through odds for different sport books” which is not found in Langseth for the same reasons as claim 1 and the arguments are not repeated here.

Summary

Thus, at least two claim elements are not found in Langseth and the examiner has therefore failed to show a prima facie case of obviousness since the examiner has not shown that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.

Claims 12-19 and 21

These claims depend from independent claim 11 and the examiner has not established a prima facie case of obviousness for these claims for at least the same reasons as set forth above for claim 11.

Claims 22- 24 and 26

Claim 22

The examiner has not established a prima facie case of obviousness for this claim because the examiner has not shown that: 1) the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.

“A program that utilizes an Internet connection to provide real time odds and information without utilizing a web browser, said real time odds and information being downloaded and stored on a user's computer, and wherein said program being incapable of placing bets”

Claim 22 recites “a program that utilizes an Internet connection to provide real time odds and information without utilizing a web browser, said real time odds and information being downloaded and stored on a user's computer, and wherein said program being incapable of placing bets” which does not exist in Langseth for the same reasons as claim 1 and the arguments are not repeated here.

“Means for navigating said display in order to acquire information said navigation means comprising a menu made up of various menus, and for any particular game or bet, the program being capable of visually cycling through odds for different sport books; and”

Claim 22 also recites “means for navigating said display in order to acquire information said navigation means comprising a menu made up of various menus, and for any particular game or bet, the program being capable of visually cycling through odds for different sport books” which is not found in Langseth for the same reasons as claim 1 and the arguments are not repeated here.

Summary

Thus, at least two claim elements are not found in Langseth and the examiner has therefore failed to show a prima facie case of obviousness since the examiner has not shown that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.

Claims 23-24 and 26

These claims depend from independent claim 22 and the examiner has not established a prima facie case of obviousness for these claims for at least the same reasons as set forth above for claim 22.

Claims 27-29

Claim 27

The examiner has not established a prima facie case of obviousness for this claim because the examiner has not shown that: 1) the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.

“Creating a program that utilizes an Internet connection to provide real time odds and information without utilizing a web browser, said real time odds and information being downloaded and stored on a user's computer, and wherein said program being incapable of placing bets”

Claim 27 recites “creating a program that utilizes an Internet connection to provide real time odds and information without utilizing a web browser, said real time odds and information being downloaded and stored on a user's computer, and wherein said program being incapable of placing bets” which does not exist in Langseth for the same reasons as claim 1 and the arguments are not repeated here.

“Providing means for navigating said display in order to acquire information, said navigation means comprising a menu made up of various menus, and for any particular game or bet, the program being capable of visually cycling through odds for different sport books”

Claim 27 also recites “providing means for navigating said display in order to acquire information, said navigation means comprising a menu made up of various menus, and for any particular game or bet, the program being capable of visually cycling through odds for different sport books” which is not found in Langseth for the same reasons as claim 1 and the arguments are not repeated here.

“Providing means for customizing the program so that the program downloads and stores, on the user's computer, occurrences connected with odds offered by one sports book or a predetermined number of sports books, processes said downloaded information, and alerts the user when a predetermined occurrence

takes place in connection with the odds offered by one sports book or a predetermined number of sports books to enable the user to acquire the information he needs automatically.”

Claim 27 also recites “providing means for customizing the program so that the program downloads and stores, on the user's computer, occurrences connected with odds offered by one sports book or a predetermined number of sports books, processes said downloaded information, and alerts the user when a predetermined occurrence takes place in connection with the odds offered by one sports book or a predetermined number of sports books to enable the user to acquire the information he needs automatically” which is not found in Langseth. The examiner has argued that navigation menus are disclosed in Langseth (Figure 14) and then argued that “it would be a matter of obvious design choice to have a menu that ... for any particular game or bet, the program is capable of visually cycling through odds from different sports books.” *See Office action at 4.*

The examiner's position is incorrect because: 1) Figure 14 is an output of the Langseth system using HTML that has graphical elements, but does not in fact disclose any menus as asserted by the examiner (*See Langseth at col. 22, lines 31-39*); and 2) even if Langseth discloses menus as asserted by the examiner, which Langseth does not, Langseth does not disclose “providing means for customizing the program so that the program downloads and stores, on the user's computer, occurrences connected with odds offered by one sports book or a predetermined number of sports books, processes said downloaded information, and alerts the user when a predetermined occurrence takes place in connection with the odds offered by one sports book or a predetermined number of sports books to enable the user to acquire the information he needs automatically” as set forth in claim 27. Thus, the claim element is not found in Langseth.

Summary

Thus, at least three claim elements are not found in Langseth and the examiner has therefore failed to show a prima facie case of obviousness since the examiner has not shown that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.

Claims 28-29

Appl. No. 09/899,711
Reply dated October 20, 2008
Reply to Office Action mailed June 19, 2008

These claims depend from independent claim 27 and the examiner has not established a prima facie case of obviousness for these claims for at least the same reasons as set forth above for claim 27.

CONCLUSION

In view of the above, it is respectfully submitted that Claims 1-3, 5-8, 10-19, 21-24 and 26-29 are allowable over the prior art cited by the Examiner and early allowance of these claims and the application is respectfully requested.

The Examiner is invited to call Applicant's attorney at the number below in order to speed the prosecution of this application.

The Commissioner is authorized to charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 07-1896.

Respectfully submitted,

DLA PIPER US LLP

Dated: October 20, 2008_____

By /Timothy W. Lohse/_____
Timothy W. Lohse
Reg. No. 35,255
Attorney for Applicant

DLA PIPER US LLP
2000 University Avenue
East Palo Alto, CA 94303
Telephone: (650) 833-2055